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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,435	04/23/2001	Diana Kim Fisler	7105	4163

7590 09/22/2003

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/840,435	Applicant(s) FISLER ET AL.	
	Examiner John Hoffmann	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

09/840, 435

2

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1731

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al. 4367012.

Ikeda et al. teaches a water resistant glass composition having silicon dioxide, alumina, boron oxide, and sodium within the claimed ranges (col. 3, lines 33-45). While Ikeda also uses zinc oxide in the composition, the zinc may be present in an amount of as small as 1 wt.% which is deemed to be a small enough amount to be encompassed by the "consisting essentially of" transitional language. Moreover, the addition of zinc oxide does not "materially affect the basic and novel characteristics" of the claimed invention because the zinc oxide enhances the moisture resistance of the glass (col. 5, lines 36-48). Thus, because Ikeda et al. teaches applicant's claimed composition, the properties achieved by the composition must, obviously, be the same. Therefore, the properties of Ikeda's composition must be the same as applicants.

It would have been prima facie obvious at the time the invention was made that the Ikeda et al.'s composition has the same properties as claimed by applicant because Ikeda et al.'s ranges overlap with applicant's claimed ranges. This fact establishes a prima facie case of obviousness (see MPEP §2144.05).

9. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meringo et al. WO 99/57073.

****The US Patent equivalent 6313050 of WO 99/57073 will be used to reference De Meringo's WO 99/57073 various teachings.****

De Meringo et al. teach a glass composition having silicon dioxide; alumina; boron oxide; calcium oxide; and sodium oxide/potassium oxide in overlapping ranges with applicant's claimed composition (col. 5, claim 1). The iron, phosphorous and titanium compounds are optional because their ranges all include zero as an option. Thus, the composition is taught by De Meringo et al. Thus, because De Meringo et al. teaches applicant's claimed composition, the properties achieved by the composition must, obviously, be the same. Therefore, the properties of De Meringo's composition must be the same as applicants.

It would have been prima facie obvious at the time the invention was made that the De Meringo et al.'s composition has the same properties as claimed by applicant because De Meringo et al.'s ranges overlap with applicant's claimed ranges. This fact establishes a prima facie case of obviousness (see MPEP §2144.05).

Response to Arguments

Applicant's arguments filed 9 July 2003 have been fully considered but they are not persuasive.

It is argued that the prima facie showing of obviousness (Ikeda) is improper, because Ikeda teaches away from the present invention. It is argued that Ikeda's usage of zirconia constitutes a "teaching away" and that page 18 of the present specification is such that "consisting essentially of" precludes zirconia. First, Ikeda does not teach to use zirconia, rather it is optional (col. 5, lines 51-53). More importantly, applicant's page 18 states that only the preferred embodiments excludes zirconia; to one of ordinary skill this would mean that zirconia could be used in a non-preferred embodiment. The present claims do not preclude zirconia.

IT is further argued that Ikeda does not disclose any examples that fall within the range. The relevance of this is not understood. MPEP 2144.05 sets forth that when the ranges overlap, a prima facie showing of obviousness exists. The burden is upon applicant to rebut the Office's prima facie showing. MPEP 2144.05 (III) sets forth two ways to rebut the showing.

It is also noted that the claims only set forth one starting material. The claims are open to adding other compositions. One can prepare a fiber from a composition A, by mixing A with another composition B : the resultant fiber would have a composition that could be very different from A.

It is further argued that the tensile value of at least 3000 is not disclosed. This is an inherent property of the composition used. If one has fibers of the same composition, one would expect the same mechanical properties.

The arguments regarding De Meringo substantially parallel the arguments made against the rejection over Ikeda. The arguments are not persuasive for substantially the same reasons.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

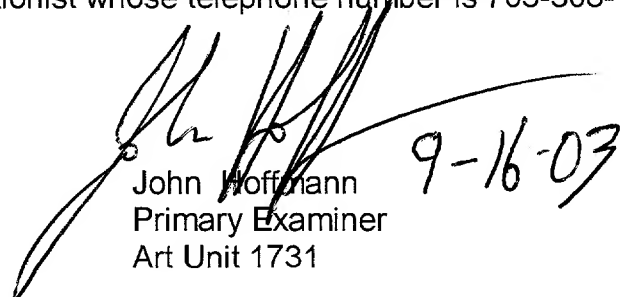
Application/Control Number: 09/840,435

Page 7

Art Unit: 1731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



John Hoffmann
Primary Examiner
Art Unit 1731

9-16-03

jmh